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### **REMARKS**

Applicants appreciate the Examiner's thorough examination of the subject application and request reconsideration of the subject application based on the foregoing amendments and the following remarks.

Claims 1-47 are pending in the subject application.

Claims 16 and 17 are acknowledged as being allowable by the Examiner.

Claims 1-15, 18-25, 29,36, 39, 42, 43 and 46-55 stand rejected under 35 U.S.C. §102 and/or 35 U.S.C. §103. Claims 26-28, 37, 38, 40, 44 and 45 were objected to as depending from a rejected base claim, however, the Examiner indicated that these claims would be allowable if appropriately re-written in independent form.

Claims 37 and 55 were canceled in the instant amendment without prejudice to prosecuting them in a continuing application.

In the interests of advancing prosecution, claim 1 was amended to more distinctly claim Applicants' invention. Such amendment, however, is made without prejudice or disclaimer to prosecuting the un-amended claim in a continuing application.

In the interests of advancing prosecution, claims 2, 7, 10, 13, 14 and 25 were amended so each now depends from claim 16. Such amendment, however, is made without prejudice or disclaimer to prosecuting the un-amended claim(s) in a continuing application.

Claims 26, 44 and 45 were re-written so as to be in independent form as suggested by the Examiner.

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In the interests of advancing prosecution, claim 29 was amended so as to include the limitation(s) of canceled claim 37. Such amendment, however, is made without prejudice or disclaimer to prosecuting the un-amended claim in a continuing application.

Claim 38 was amended so as to depend from claim 29 in view of the cancellation of claim 37.

In the interests of advancing prosecution, claim 42 was amended so as to include the limitation(s) of canceled claim 37. Such amendment, however, is made without prejudice or disclaimer to prosecuting the un-amended claim in a continuing application.

Claim 46 was amended so as to make clear that the translating of the first arm was a linear translation.

The amendments to the claims are supported by the originally filed disclosure.

#### 35 U.S.C. §102 REJECTIONS

Claims 1-9, 13-15, 18-25, 29-34, 36, 39, 42 and 46-47 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated for the reasons provided on pages 2-5 of the above-referenced Office Action. Because claims were amended in the foregoing amendment, the following discussion refers to the language of the amended claim(s). However, only those amended features specifically relied on in the following discussion shall be considered as being made to overcome the prior art reference. The following addresses the specific rejections provided in the above-referenced Office Action.

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**CLAIMS 1-9, 13-15, 18-25, 29-34, 36, 39, 42 and 46-55**

The Examiner has rejected claims 1-9, 13-15, 18-25, 29-34, 36, 39, 42 and 46-55 under 35 U.S.C. §102(b) as being anticipated by Paltiel [USP 5,647,373] for the reasons provided on pages 2-4 of the above referenced Office Action. Applicants respectfully traverse.

As indicate above claim 55 was canceled. As such, Applicants do not believe that the within rejection as to this claim need be addressed further herein. Applicants would note that claim 55 was canceled in the interests of advancing prosecution without prejudice or disclaimer to prosecuting the un-amended claim in a continuing application.

As indicated above, in the interests of advancing prosecution, each of claims 2, 7, 10, 13, 14 and 25 were amended so each claim now depends from claim 16, which claim is acknowledged as being allowable in the above-referenced Office Action. As such, each of claims 2, 7, 10, 13, 14 and 25 and each of claims 3-9, 15, and 18-24 are considered to be allowable at least because of the dependence from a base claim that is considered to be allowable.

As also indicated above each, in the interests of advancing prosecution each of claims 29 and 42 was amended so as to include the limitation(s) of canceled claim 37. In as much as the added limitation(s) of claim 37 generally comports with the last wherein clause of claim 16, which claim is indicated as being allowable, Applicants thus believe that each of claims 29 and 42 also is allowable. As also indicated above, the foregoing amendments to claims 29 and 42 is being done without prejudice or disclaimer to prosecuting the un-amended claim(s) in a continuing application.

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As to claims 30-34, 36, 39, 50 and 53, each of these is considered to be allowable at least because of the dependence from a base claim (i.e., claim 29) that is considered to be allowable.

As to claims 51 and 54, each of these is considered to be allowable at least because of the dependence from a base claim (i.e., claim 42) that is considered to be allowable.

As to claim 46, this claim was amended in the foregoing amendment to indicate that the first arm is being linearly translated from an initial position to any of a number of other positions spaced from the initial position, thereby also linearly translating the penetrating member proximal portion in a direction towards the target area. It is respectfully submitted that the cited art does not disclose, describe, teach or suggest such linearly translating of the penetrating member of the needle driver disclosed or described therein.

As to claims 47 and 48, each of these is considered to be allowable at least because of the dependence from a base claim (i.e., claim 46) that is considered to be allowable.

As to claim 1, this claim was amended to more particularly indicate that the apparatus of the present invention is being manipulated by a manipulating device and that the manipulating device is operable coupled to the first arm and the first drive mechanism such that the apparatus of the present invention can be positioned in proximity to the entry point of the object containing the target area. In the above referenced Office Action, the Examiner indicated that certain language in the claim 1 was considered to be functional and thus not imposing any structural limitations. Applicants submit that the foregoing amendment to claim 1 adds further structural limitations that clearly distinguish claim 1 from the cited art.

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As to claims 49 and 52, each of these is considered to be allowable at least because of the dependence from a base claim (i.e., claim 1) that is considered to be allowable.

It is respectfully submitted that claims 1-9, 13-15, 18-25, 29-34, 36, 39, 42 and 46-55 are patentable over the cited reference for the foregoing reasons.

#### **CLAIMS 1-6 & 46-47**

Claims 1-6 and 46-47 stand rejected as being anticipated by Stoianovici (WO98/36688) for the reasons provided on page 4-5 of the above referenced Office Action. Applicants respectfully traverse.

As indicated above, in the interests of advancing prosecution claim 2 was amended so it now depends from claim 16, which claim is acknowledged as being allowable in the above-referenced Office Action. As such, each of claims 2-6 is considered to be allowable at least because of the dependence from a base claim (i.e., claim 16) that is considered to be allowable.

As indicated above, claim 46 was amended in the foregoing amendment to indicate that the first arm is being linearly translated from an initial position to any of a number of other positions spaced from the initial position, thereby also linearly translating the penetrating member proximal portion in a direction towards the target area. It is respectfully submitted that the cited art does not disclose, describe, teach nor suggest such linearly translating of the penetrating member of the needle driver disclosed or described therein. As to claim 47, this claim is considered to be allowable at least because of the dependence from a base claim (i.e., claim 46) that is considered to be allowable.

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As indicated above, claim 1 was amended to more particularly indicate that the apparatus of the present invention is being manipulated by a manipulating device and that the manipulating device is operable coupled to the first arm and the first drive mechanism such that the apparatus of the present invention can be positioned in proximity to the entry point of the object containing the target area. In the above referenced Office Action, the Examiner indicated that certain language in the claim 1 was considered to be functional and thus not imposing any structural limitations. Applicants submit that the foregoing amendment to claim 1 adds further structural limitations that clearly distinguish claim 1 from the cited art.

It is respectfully submitted that claims 1-6 and 46-47 are patentable over the cited reference for the foregoing reasons.

The following additional remarks shall apply to each of the above.

As provided in MPEP-2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Or stated another way, "The identical invention must be shown in as complete detail as is contained in the ... claims. *Richardson v Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ 2d. 1913, 1920 (Fed. Cir. 1989). Although identify of terminology is not required, the elements must be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990). It is clear from the foregoing remarks that the above identified claims are not anticipated by either of the two cited references.

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It is respectfully submitted that for the foregoing reasons, claims 1-9, 13-15, 18-25, 29-34, 36, 39, 42 and 46-55 are patentable over either of the two cited references and thus, satisfy the requirements of 35 U.S.C. §102(b). As such, these claims, including the claims dependent therefrom are allowable.

### 35 U.S.C. §103 REJECTIONS

Claims 10-12, 35 and 43 stand rejected under 35 U.S.C. §103 as being unpatentable over Paltici [USP 5,647,373] for the reasons provided on pages 5-6 of the above referenced Office Action. Applicants respectfully traverse. Because claims were amended in the instant amendment, the following discussion refers to the language of the amended claims. However, only those amended features specifically relied upon to distinguish the claimed invention from the cited prior art shall be considered as being made to overcome the cited reference.

As indicated above, in the interests of advancing prosecution each of claims 7, 10 were amended so each claim now depends from claim 16, which claim is acknowledged as being allowable in the above-referenced Office Action. As such, claim 10 and each of claims 11-12 are considered to be allowable at least because of the dependence from a base claim (i.e., claim 16) that is considered to be allowable.

As indicated above, in the interests of advancing prosecution each of claims 29 and 42 was amended so as to include the limitation(s) of canceled claim 37. In as much as the added limitation(s) of claim 37 generally comports with the last wherein clause of claim 16, which claim is indicated as being allowable, Applicants thus believe that each of claims 29 and 42 also

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is allowable. As also indicated above, the foregoing amendments to claims 29 and 42 are being done without prejudice or disclaimer to prosecuting the un-amended claim(s) in a continuing application.

As to claims 35 and 43, each of these is considered to be allowable at least because of the dependence from a base claim (i.e., claim 29 or claim 42) that is considered to be allowable.

As provided in MPEP 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F. 2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F. 2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). As provided above, the reference(s) cited, alone or in combination, include no such teaching, suggestion or motivation.

It is respectfully submitted that for the foregoing reasons, claims 10-12, 35 and 43 are patentable over the cited reference(s) and satisfy the requirements of 35 U.S.C. §103. As such, claim 10-12, 35 and 43 are considered to be allowable.

CLAIMS 26-28, 37, 38, 40, 44 & 45

In the above-referenced Office Action, claims 26-28, 37, 38, 40, 44 and 45 were objected to as being dependent upon a rejected base claim. It also was provided in the above-referenced Office Action, however, that these claims would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claim(s).



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Claims 44 and 45 were re-written in the foregoing amendment so as to be in independent form and to include all the limitations of the base claim there being no intervening claim(s) and claim 26 was re-written in the foregoing amendment so as to be in independent form and to include all the limitations of the base claim and the intervening claim(s).

As to claims 27 and 28, these claims were not re-written in independent form as suggested by the Examiner as each of these claims depends from claim 26. Applicants however, reserve the right to later amend the subject application so as to present any one or more of claims 27 or 28 in independent form or to add one or more independent claims that contain the limitations of any one or more of claims 27 and 28. Accordingly, claims 25-28, 44 and 45 are considered to be in allowable form.

As to claims 37 and 38, these claims were not re-written in independent form as suggested by the Examiner, rather in the interests of advancing prosecution the limitations of only claim 37 were added to the base claim, claim 29. Applicants however, reserve the right to later amend the subject application so as to present any one or more of claims 37 and 38 in independent form or to add one or more independent claims that contain the limitations of any one or more of claims 37 and 38.

It is respectfully submitted that the subject application is in a condition for allowance. Early and favorable action is requested.

Because the total number of claims and/or the total number of independent claims post amendment now exceed the highest number previously paid for, a check is enclosed herewith for


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the required additional fees. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, the Commissioner is hereby authorized and requested to charge Deposit Account No. 04-1105.

Respectfully submitted,  
Edwards & Angell, LLP

Date: August 24, 2004

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